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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,677	07/24/2000	Guy Nathan	871-85	6899
23117 7590 03/09/2011 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER SALTARELLI, DOMINIC D	
			ART UNIT 2421	PAPER NUMBER
			MAIL DATE 03/09/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/621,677

**Applicant(s)**

NATHAN, GUY

**Examiner**

DOMINIC D. SALTARELLI

**Art Unit**

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21, 23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GA-06)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed February 17, 2011 have been fully considered but they are not persuasive.

First, applicant argues that Martin does not teach the claimed feature of selecting songs from a list, instead teaching an input prompt that requires a user to type in a song title.

In response, the examiner has explicitly stated that Martin does not teach said feature, and most recently introduced Pritt to demonstrate that pop-up menus were well known and would have been obvious to try, providing the benefits that are immediately apparent to anyone familiar with graphic user interfaces.

Second, applicant argues that Alavi does not explicitly teach a verification stage that determines whether a questionnaire has been completed, only that it sorts answers upon receiving them.

In response, Alavi states "After the host computer 2 receives the answers to the **complete** survey, the timer 12 will be activated and the controller 7 will be connected to the Internet 13 for a predetermined number of minutes, at no cost to the responder." [emphasis added] The examiner fails to see how Alavi could function without a verification step, since it is explicitly stated that the free use reward can only be attained by actually completing the survey.

Last, applicant argues that there is no motivation to use pop-up menus for selection as taught by Pritt, since Pritt's user interface is unrelated to song selections, thus the motivation applied constitutes improper hindsight reasoning.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is the examiner's contention that the motivation cited, that said menus provide an intuitive interface for item selection and a readily understandable listing of available items such that a user can quickly identify and select one without needs to know ahead of time and manually type in the name of said item, was knowledge within the level of ordinary skill at the time the claimed invention was made, and readily apparent from viewing the Pritt reference (or any other prior art which utilizes pop-up menus).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (5,848,398, provided by applicant, January 29, 2001) [Martin] in view of Wilder (5,408,417, of record), Banks et al. (5,559,714, of record) [Banks], Mauldin (5,748,954, of record), Alavi (5,970,467, of record), and Pritt et al. (5,473,746) [Pritt].

Regarding claims 21 and 25, Martin discloses a jukebox system, connected to a distribution network controlled by a host server (fig. 1) comprising:

a display, operable to display at least a customer interface, wherein the customer interface comprises at least one displayed option, corresponding to at least one song, for selecting the corresponding song to be played (col. 7 line 44 - col. 8 line 12);

a memory that stores at least songs that may be played on the jukebox apparatus in response to selections from a customer (storage unit 93, col. 3, lines 30-36);

an audio reproduction system providing audio (fig. 1, audio reproduction 127 and speaker 129);

a communication system for enabling the jukebox device to communicate with the distribution network (illustrated in fig. 1, as the jukeboxes and central controller and connected via modems 17 and 19); and

a fee payment device for accepting payment of a fee (fig. 1, COIN DET. 126, col. 6, lines 5-20);

wherein the display is further operable to display at least one option for selecting a song not yet available on the jukebox device for download to the jukebox device (users are prompted to request songs for download to the jukebox, col. 7, lines 36-43);

wherein an order is sent to the jukebox system via a file downloaded on the jukebox system from the host server, the order being stored by the jukebox system and used to play one or more predetermined audiovisual records at one or more predetermined times (audiovisual advertisements are sent to the plural remote jukebox systems from the server that include information that specifies which advertisements should be run at what times, col. 9, lines 1-34).

Martin fails to disclose the display comprises a touch screen portion and the displayed options are touch selectable, where the display displays a list of songs in a popup menu from which the users selects said songs not yet available, and the display is still further operable to display, said display triggered in response to the purchase, by a user, of predetermined songs, a questionnaire different from touch selectable options for selecting songs for playback and touch selectable options for selecting songs for download, comprising one or more questions for gathering customer information, wherein the touch-screen is operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory, and a song request routine for requesting at least one new song for download from the host server, wherein when a number of time that a

same song is selected exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song be downloaded from the host server to the audiovisual reproduction system, and a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed.

In an analogous art, Wilder teaches an audiovisual reproduction system with a touch screen for user selections (col. 4, lines 13-22), providing an intuitive form of user selections from a very flexible interface.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin to include a touch screen, as taught by Wilder, for the benefit of providing an intuitive form of user selections from a very flexible user interface.

Martin and Wilder fail to disclose where the display displays a list of songs in a popup menu from which the users selects said songs not yet available , and the display is still further operable to display, said display triggered in response to the purchase, by a user, of predetermined songs, a questionnaire different from touch selectable options for selecting songs for playback and touch selectable options for selecting songs for download, comprising one or more questions for gathering customer information, wherein the touch-screen is operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory,

and a song request routine for requesting at least one new song for download from the host server, wherein when a number of time that a same song is selected exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song be downloaded from the host server to the audiovisual reproduction system, and a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed.

In an analogous art, Banks teaches a vending machine system wherein a display is operable to display a questionnaire comprising one or more questions for gathering customer information upon purchase of a predetermined product by the user (the questionnaire is displayed after each purchase), operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory (col. 7, lines 44-65), providing the benefit of valuable customer feedback regarding customer interests and information to interested parties (col. 8, lines 37-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin and Wilder to include display of a questionnaire upon purchase of a predetermined product by the user, comprising one or more questions for gathering customer information, operable to accept customer input corresponding to the answers to the one or more questions, and wherein the answers are saved to a questionnaire response file in the memory,



as taught by Banks, providing the benefit of valuable customer feedback to interested parties, such as content distributors and/or marketing firms. The product being purchase is a predetermined song, since the system disclosed by Martin is a musical jukebox with a limited selection of songs.

Martin, Wilder, and Banks fail to disclose the display displays a list of songs in a popup menu from which the users selects said songs not yet available, a song request routine for requesting at least one new song for download from the host server, wherein when a number of times that a same song is selected exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song be downloaded from the host server to the audiovisual reproduction system, and a reward routine for presenting the customer with a reward is processed.

In an analogous art, Mauldin discloses downloading files to a local system from remote locations according to a heuristic rule that downloads selections according to popularity, making the most requested files (the predetermined threshold being a function of how many requests are made, since it is the most popular file that is downloaded) locally available for consumption (col. 2, lines 25-51).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Wilder, and Banks according to the disclosure of Mauldin such that when the number of times that a same song is

selected exceeds a predetermined threshold, the audiovisual reproduction system sends a request to the host server to request that the selected song be downloaded from the host server to the audiovisual reproduction system.

Martin, Wilder, and Banks fail to disclose the display displays a list of songs in a popup menu from which the users selects said songs not yet available and a reward routine for presenting the customer with a reward is processed, after the determination routine has determined whether the questionnaire was completed.

In an analogous art, Alavi teaches a method for accurately collecting market research survey data by involves providing a reward to users upon completion of a survey (col. 1 line 50 - col. 2 line 24).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Wilder, Banks, and Mauldin to and a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed, as taught by Alavi, for the benefit of providing incentive to users to fully complete presented surveys.

Martin, Wilder, Banks, Mauldin, and Alavi fail to disclose the display displays a list of songs in a popup menu from which the users select said songs which are not yet available.

It is notoriously well known in the art to utilize pop-up menus to enable users to make selections of desired content, said menus providing an intuitive

interface for item selection and a readily understandable listing of available items such that a user can quickly identify and select one without needs to know ahead of time and manually type in the name of said item. One example of such found in the prior art is Pritt, who teaches it was well known at the time to use pop-up menus for making item selections (col. 4 line 64 - col. 5 line 19).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin, Wilder, Banks, Mauldin, and Alavi to include using a pop-up menu to display a list of songs from which the users select said songs which are not yet available.

Regarding claim 23, Martin, Wilder, Banks, Mauldin, Alavi, and Pritt disclose the system of claim 21, wherein the reward routine provides the customer a free song selection for completing the questionnaire (Alavi teaches providing free, limited use of the system in return for completing a survey, and according to Martin, the system is a song playing jukebox, thus free limited use of a jukebox is access to a free song selection).

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2421

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dominic D Saltarelli/  
Primary Examiner, Art Unit 2421